



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Prior Application No: 09 132,231

Examiner: John S. Brusca

Art Unit: 1631

RECEIVED

MAY 19 2003

TECH CENTER 1600 2900  
**REQUEST FORM FOR CONTINUING PROSECUTION**  
**APPLICATION UNDER 37 C.F.R. § 1.53(d)**

**MAIL STOP CPA**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



**21839**

Sir:

This is a request for filing a [X] continuation [ ] divisional application under 37 C.F.R. § 1.53(d) (Continuing Prosecution Application) of prior Application No. 09/132,231, filed on August 11, 1998, for METHOD FOR PRODUCING NOVEL DNA SEQUENCE WITH BIOLOGICAL ACTIVITY by the following named inventors:

(a) Full Name Marshall S. Horwitz  
(b) Full Name Lawrence A. Loeb  
(c) Full Name \_\_\_\_\_

[X] Applicant(s) hereby requests that the above-captioned application **NOT BE PUBLISHED** under 35 U.S.C. § 122(b) and 37 C.F.R. § 1.211. The undersigned hereby certifies that the invention disclosed in this application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

This application is being filed by less than all the inventors named in the prior application. In accordance with 37 C.F.R. 1.53(d)(4), the Director is requested to delete the name(s) of the following person or persons who are not inventors of the invention being claimed in this application:

(a) Full Name \_\_\_\_\_  
(b) Full Name \_\_\_\_\_  
(c) Full Name \_\_\_\_\_

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The above-identified prior application is hereby expressly abandoned as of the filing date of this new application. Please use all the contents of the prior application file wrapper, including the drawings, as the basic papers for the new application. (Note: 37 C.F.R. § 1.53(b) must be used for applications where the prior application is not to be abandoned.)

It is understood that secrecy under 35 U.S.C. § 122 is hereby waived to the extent that if information or access is available to any one of the applications in the file wrapper of a 37 C.F.R. § 1.53(d) application, be it either this application or a prior application in the same file wrapper, the Patent and Trademark Office may provide similar information or access to all other applications in the same file wrapper.

1.  Applicant(s) suggests Figure \_\_\_\_\_ for inclusion on the front page of the patent application publication and patent.
2.  Applicant(s) requests that the published application include the following assignment information: \_\_\_\_\_.
3.  Applicant(s) requests suspension of action by the Office until at least \_\_\_, which does not exceed three months from the filing of this CPA, in accordance with 37 C.F.R. § 1.103(b). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
4.  Enter the amendment previously filed on \_\_\_ under 37 C.F.R. § 1.116, but unentered, in the prior application.
5.  The election made previously in the prior application does not carry over to this application.
6.  A preliminary amendment is enclosed.
7.  Small entity status is hereby claimed.
8.  The filing fee is calculated below on the basis of the claims existing in the prior application as amended at 3 and 5 above:

| <b>CLAIMS</b>                                                            |                      |            |                     |                    |                   |
|--------------------------------------------------------------------------|----------------------|------------|---------------------|--------------------|-------------------|
|                                                                          | <b>NO. OF CLAIMS</b> |            | <b>EXTRA CLAIMS</b> | <b>RATE</b>        | <b>FEES</b>       |
| Basic Application Fee                                                    |                      |            |                     |                    | \$750.00 (1001)   |
| Total Claims                                                             | 20                   | MINUS 20 = | 0                   | × \$18.00 (1202) = | -0-               |
| Independent Claims                                                       | 20                   | MINUS 3 =  | 17                  | × \$84.00 (1201) = | \$1,428.00        |
| If multiple dependent claims are presented, add \$280.00 (1203)          |                      |            |                     |                    |                   |
| Total Application Fee                                                    |                      |            |                     |                    | \$2,178.00        |
| If small entity status is claimed, subtract 50% of Total Application Fee |                      |            |                     |                    |                   |
| <b>TOTAL APPLICATION FEE DUE</b>                                         |                      |            |                     |                    | <b>\$2,178.00</b> |

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Page 3

9.  This application is being filed without a filing fee. Issuance of a Notice to File Missing Parts of Application is respectfully requested.

10.  A check in the amount of \$ 2,178.00 is enclosed for the fee due.

11.  Charge \$ \_\_\_\_\_ to Deposit Account No. 02-4800 for the fee due.

12.  The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

13.  Priority of Application No. \_\_\_, filed on \_\_\_, in \_\_\_ (country) is claimed under 35 U.S.C. § 119.  
 The certified copy of the priority application  
 is enclosed.  
 was filed on \_\_\_ in prior Application No. \_\_\_, filed on \_\_\_, and acknowledged by the Examiner on \_\_\_ in Paper No. \_\_\_.  
 has not yet been filed.

14.  Please amend the specification by inserting before the first line the sentence:  
 --This application is a  continuation  divisional of U.S. Application No. \_\_\_, filed on \_\_\_, which was a national stage filing under 35 U.S.C. § 371 of International Application No. \_\_\_, filed on \_\_\_.--.  
 --This application is a  continuation  divisional of U.S. Application No. 09/132,231, filed on August 11, 1998, which is a continuation of Application No. 08/316,415 filed on September 30, 1994, which is a continuation of Application No. 08/105,108, filed on August 11, 1993, which is a continuation of Application No. 07/881,607, filed on May 12, 1992, which is a continuation of Application No. 07/368,674, filed on June 19, 1989, which is a continuation-in-part of Application No. 06/887,070, filed July 17, 1986.--.

15.  Also enclosed \_\_\_.

16.  The power of attorney in the prior application is to David D. McMasters, Reg. No. 33,963 and Donna M. Meuth, Reg. No. 36,607.  
a.  The power appears in the original papers in the prior application.  
b.  Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.  
c.  Recognize as Associate Attorney or Agent Sharon E. Crane, Ph.D., Reg. No. 36,113.  
d.  Address all future communications to: (May only be completed by applicant, or attorney or agent of record.)

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BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, Virginia 22313-1404

Date: May 15, 2003

By: Sharon E. Crane  
Sharon E. Crane, Ph.D.  
Registration No. 36,113

ADDRESS OF SIGNATOR:

BURNS, DOANE, SWECKER & MATHIS, L.L.P.       inventor(s)  
P.O. Box 1404       assignee of complete interest  
Alexandria, Virginia 22313-1404       attorney or agent of record  
(703) 836-6620       filed under 37 C.F.R. § 1.34(a)

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| <b>TOTAL APPLICATION FEE DUE</b>                                         |                  |            |                 |                    | <b>\$2,178.00</b> |

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P.O. Box 1404  
Alexandria, Virginia 22313-1404

Date: May 15, 2003

By: Sharon E. Crane  
Sharon E. Crane, Ph.D.  
Registration No. 36,113

ADDRESS OF SIGNATOR:

BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620

inventor(s)  
 assignee of complete interest  
 attorney or agent of record  
 filed under 37 C.F.R. § 1.34(a)